

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mark T. Marshall et al. Examiner: Pamela M. Bays
Serial No. 10/630,547 Group Art: 3766
Filing Date: July 29, 2003 Docket No.: P0011313.01
Title: MEDICAL SYSTEM INCLUDING A NOVEL BIPOLAR PACING
PAIR

Pre-Appeal Brief Request for Review

MAIL STOP Appeal Brief
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir,

The following is submitted responsive to the Advisory Action dated January 19, 2011. A Notice of Appeal is submitted herewith.

Any required fee will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.16, 1.17, 1.136(a), or any additional fees to Deposit Account 13-2546.

Remarks

Claims 1, 2 and 7 – 16 are pending. Reconsideration of the rejections of all claims is respectfully requested.

I. Rejection under Section 103 –Carson in view of Helland

Claims 1, 2 and 7 - 10 stand rejected under 35 U.S.C. Section 103 as being obvious over Carson (US 5,931,862) in view of Helland (US 5,466,254). This rejection is again respectfully traversed.

In the Final Office Action, the Examiner responded to the Applicants' previous arguments with arguments that, as asserted by Applicants, were irrelevant to the question of patentability of the claims. The Attorney for Applicants unfortunately allowed himself to be drawn in by these arguments and responded to them, based on the understanding that if the Examiner provided a rationale for rejection that was erroneous, the rejection was improper. *

In the Advisory Action, the Examiner argues that Applicant's responses were irrelevant to the question of patentability. Of course they were. They were submitted in response to irrelevant arguments by the Examiner.

The Attorney for Applicants will do his best not to fall for that one again. However, because the Examiner has now taken the position that the issues raised in the Final Office Action and Applicants response are irrelevant, it appears we now must go on to the new explanation for rejection argued in the Advisory Action and back to the arguments in the Office Action of May 19, 2010.

* The Attorney for Applicants respectfully notes that the recently issued Patent Office guidelines for Section 103 rejections fully support this position

As best understood by Applicants, based upon all of the various statements and positions taken in the Office Actions, the Examiner's final position is as follows, restated in syllogism form:

- a) Carson discloses electrodes in which a porous layer formed the electrodes, allowing conduction therethrough while preventing contact between the electrodes and tissue.
- b) Helland discloses delivery of pacing pulses between electrodes on two different leads.
- c) therefore it is obvious to deliver a pacing pulse between an electrode as disclosed in Helland on one lead and an electrode as disclosed in Carson on the other and to configure a pacing pulse generator to do so.

Applicants do not and have not disputed the facts in the premises a) and b) above. They merely dispute that the conclusion c) follows therefrom.

Those of the Examiner's arguments which have not been discarded ignore the fact that neither the Helland nor the Carson reference discloses delivery of pacing pulses between two electrodes, one provided with a porous coating as in Carson, one not. This is true regardless of whether the electrodes are located on the same or different leads. The addition of Helland to Carson does not provide this required teaching missing from Carson.

Carson expressly discloses delivery of pacing pulses between two porous electrodes coated with Carson's porous coatings, i.e. the atrial pacing and sensing electrodes. It does not disclose delivery of a pacing pulse between an uncoated electrode and an electrode having Carson's porous coatings.

The Attorney for Applicants understands the Examiner to take the position that Helland discloses adapted for intimate contact with tissue, as required by the claims. Helland, like Carson thus discloses delivery of pacing pulses between two electrodes of the same type. Helland, like Carson, simply does not suggest or teach delivery of pacing pulses between electrodes of the two differing types required by the claims.

As both references omit the same essential teaching, their combination cannot somehow provide it.

In case the Examiner is intending to argue that the Carson reference suggests delivery of a pacing pulse between the tip electrode 20 and one of the porous coated electrodes, the Attorney for Applicants respectfully notes that While this might be theoretically possible with the Carson lead, no hint is given that it would be possible or should be done using the Carson pulse generator.

The fact that both types of electrodes as claimed are found in the prior art does not in and of itself render it obvious to use them for all purposes that electrodes may be put to. The claims require a pulse generator coupled to the two differing electrode types and providing pacing pulses between them as claimed. The Examiner has yet to actually specifically address this aspect of the invention in any clear fashion. As such, the arguments advanced by the Examiner to date are respectfully asserted to be inadequate under the new guidelines for Section 103 rejections.

III. Rejections under Section 103 –Carson in view of Helland and Hull or Soukup

Claims 11 - 15 and 16 stand rejected under 35 U.S.C. Section 103 as being obvious over Carson (US 5,931,862) in view of Helland (US 5,466,254) i view of Hull , et al. (US 5,269,810) or Soukup, et al (US 5,466,252) This rejection is respectfully traversed.

These rejections all depend upon the erroneous rejection of claim 1 as discussed above. Withdrawal of these rejections is correspondingly requested.

Conclusion

Applicants again respectfully assert that the present claims are in condition for allowance. Withdrawal of the instant rejections and issuance of a Notice of Allowance is respectfully requested.

Should any issues remain outstanding, the Examiner is urged to telephone the undersigned to expedite prosecution. The Commissioner is authorized to charge any deficiencies and credit any overpayments to Deposit Account No. 13-2546.

Respectfully submitted,

January 28, 2011
Date

/Reed A. Duthler/
Reed A. Duthler, Reg. No. 30, 626
(763) 526-1564
Customer No. 27581